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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,387	04/18/2001	Paul Brand	P01.0064	5055

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EXAMINER

OROEPEZA, FRANCES P

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,387

Applicant(s)

BRAND ET AL.

Examiner

Francès P. Oropeza

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 16-17 is/are rejected.
- 7) ☒ Claim(s) 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 08 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. Figures 3 and 4 are objected to because in figure 3, the reference numeral 33 below the ceramic plug (26) lacks a line to indicate an element, and in figure 4, reference numeral 30 appears to lack a line to indicate an element. Correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiff (US 5383913). Schiff discloses a metal sleeve (48), read as metallic tubular member, disposed in a housing (30), containing a plurality of interior components (figure 3) to make electrical contact with the plug (18) (figures 2, 3, and 7).

As related to claim 10, the screw pin assembly area (51) of the connector socket (33) is read as the lateral opening. The internal tip of the threaded bore (50) provides the contact surface for the cathode contact (27), read as the internal component providing a contact surface the electrical connection between the tip cathode (22) and the wire (44) connecting the lead to the circuitry in the casing (figures 2 and 3; c 7, ll 10-14).

As related to claim 11, the connector socket (33), read as the plug (26), is constructed of insulating material (47) (figures 2 and 3).

As related to claims 16, the plug (35) is representative of the locking arrangement.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint Inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The Applicant is advised of the obligation under 37 CFR 1.56 to point out the Inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8, 9, 11, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US 5383913) in view of Truex et al. (US 4934366). As discussed in paragraph 2 of this action, Schiff discloses the claimed invention except for:

- the tubes ends being bonded (claim 8) or welded (claim 9) to the housing,
- the plug being ceramic (claim 11), and
- the plug being mechanically attached (claim 11), soldered (claim 12) or bonded (claim 13).

As related to claims 8 and 9, Truex et al. teach implantable device component assembly using welding or bonding for the purpose of securing the barrel assembly to the device housing. It would have been obvious to one having ordinary skill in the art at the time of the invention to

Art Unit: 3762

have used bonding or welding in the Schiff system in order to seal the tubular member to the device housing enabling the inside of the device to be hermetically sealed to protect the device from bodily fluids (figure 4 - (78); c 6, ll 46-48; c 3, ll 9-14).

As related to claim 11, Truex et al. teach inert materials of construction using ceramic for the purpose of providing system elements that will insulate system components and not conduct electricity. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used ceramic as the electrically inert material in the Schiff system in order to provide a material that can be effectively hermetically sealed to protect the device from bodily fluids. (c 5, ll 37-44).

As related to claims 11, 12 and 13, Truex et al. teach ceramic component mounting using mechanical attachment, soldering or bonding for the purpose of securing the ceramic component in position. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used mechanical attachment, soldering or bonding to secure the ceramic components in the Schiff system in order to provide securely connected components that can be effectively hermetically sealed to protect the device from bodily fluids. (c 5, ll 37-44; c 6, l 64 – c 7, l 6; c 7, ll 40-46).

5. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US 5383913) in view of Peers-Trevarton (US 4784141). As discussed in paragraph 2 of this action, Schiff discloses the claimed invention except for an at least partially removable locking arrangement in the second tube end. Peers-Trevarton teaches lead confinement using a lead locking mechanism (44) for the purpose of securing the lead in the cardiac pacer header. Several locking mechanism components, the screw (52) and cap (56), are removable. It would have been

Art Unit: 3762

obvious to one having ordinary skill in the art at the time of the invention to have used a lead locking mechanism in the Schiff system in order to reduce the size of the cardiac pacer by reducing the thickness of the neck portion of the cardiac pacer to enable the smaller device to be implanted in the body relatively comfortably and inconspicuously (figures 7 and 10; c 1, ll 31-36 and 60-64; c 5, ll 19-37).

Allowable Subject Matter

6. Claim 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

FP
2/13/03

Angela D. Sykes

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